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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,458	03/19/2004	Michael Tate Wood	C.R. DANIELS-PA-6	7254
7590 OBER / KALER c/o Royal W. Craig 120 East Baltimore Street Baltimore, MD 21202		01/07/2008	EXAMINER PICKETT, JOHN G	
			ART UNIT 3728	PAPER NUMBER
			MAIL DATE 01/07/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No. 10/804,458	Applicant(s) WOOD ET AL.	
	Examiner Greg Pickett	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In view of the Supplemental Appeal Brief filed on 5 June 2007, **PROSECUTION IS HEREBY REOPENED**. A new grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

2. Claims 1-4 are pending in the application. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Oath/Declaration

3. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be **material to patentability** as defined in **37 CFR 1.56**.

Applicant's Declaration recites "material to the examination" and "Title 37, Code of Federal Regulations, §1.56(a)". This is insufficient acknowledgement.

Claim Rejections - 35 USC § 103

4. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Bennett** (US 2003/0106819 A1; available under 35 USC 102(e); previously provided) in view of **Jones et al** (US 6,256,922; previously provided).

Claim 1: Bennett discloses a long gun case in Figure 4. As Bennett specifically states like numerals indicate like elements (paragraph [0011]), the notations of Figures 1-3 will be used to denote the features of Figure 4. Accordingly, Bennett discloses an outer shell 26, a padded inner liner 28. Although Figure 3 shows the film 26 on the exterior surface, paragraph [0011] specifically states that the padding 28 is located on the inner surface. Bennett is formed by folding over a sheet and sewing the edges closed. Bennett uses a double stitching and may be considered "reinforced" around a peripheral seam. Bennett discloses an end opening and first fold-over flap 14 movable to close the end opening. Bennett discloses all limitations claimed by the applicant except for the fabric outer shell and the sidelong access opening.

Jones is in applicant's field of endeavor and teaches a fabric material (see Col. 4: 30-33). It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the outer shell of Bennett in a fabric material in order to

have a sturdy, lightweight casing. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. One of ordinary skill in the art would have reasonably expected success since the layers of Bennett are connected by adhesive (paragraph [0012]), which is fully capable of operating with a fabric.

Further, Jones teaches a sidelong openings covered by flaps (see Figure 1, flaps denoted by numbers 100, 200, 50, 60, 90. See also Figure 7). Jones teaches these openings for access to such features as the shell insertion portion or magazine insertion portion (see e.g. Col. 2: 43-48). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the case of Bennett with sidelong openings and fold-over flaps at the rear and mid portion of the case in order to have access to the rifle butt, shell insertion portions, or magazine insertion portions. Access to the butt would be desirable since rifles sometimes have special features on the butt portion (e.g. a compass or compartment). One of ordinary skill in the art would have reasonably expected success since both cases are made in a similar manner.

Once modified with a sidelong opening at the rear and mid portions, Bennett-Jones would have a conjoined sidelong and end access opening and be fully capable of being turned inside-out. Turning the item inside-out is considered an intended use.

Claim 2: Both Bennett and Jones disclose closure flaps attached by hook-and-loop fasteners (Bennett 22 and Jones 160).

Claim 3: Jones is evidence that a woven fabric was known in the art (see Col. 4: 30-33). To replace the non-woven liner of Bennett with a woven liner would have been obvious to one of ordinary skill, based upon the desired strength of the liner. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Further, Bennett discloses liner 28 impregnated with rust inhibitors (paragraph [0016]) and it would have been obvious to include this feature in the combination in order to protect the retained firearm from rusting.

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett-Jones as applied to claim 1 above, and further in view of Broun et al (US 5,431,970; previously provided).

Bennett-Jones, as applied to claim 1 above, discloses the claimed invention except for the middle layer of padding.

Broun is in applicant's field of endeavor and teaches a tri-layer protective material for gun cases (e.g. Figure 3), where the middle layer 14 is made of foam (i.e. padding) to protect against impact and abrasion. The padding also provides for flotation (Col. 4: 49-53). To modify the case of Bennett-Jones with an additional middle layer as taught by Broun would have been obvious to one of ordinary skill in the art for the purpose of additional impact resistance and/or flotation.

Response to Arguments

6. Applicant's arguments with respect to claims 1-4 have been fully considered but are moot in view of the new ground(s) of rejection.

Inasmuch as the applicant's arguments may apply to the above rejections, applicant should be aware that events have overtaken the applicant's position that there must be some teaching, suggestion, or motivation in the prior art to establish a *prima facie* case of obviousness.

The Supreme Court has provided guidelines for determining obviousness based on the Graham factors. *KSR Int 'l v. Teleflex Inc.*, 127 S.Ct. 1727, 82 USPQ2d 1385 (2007). "A combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* at 1731, 82 USPQ2d at 1396. "When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability." *Id.* For the same reason, "if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond that person's skill." *Id.* at 1740, 82 USPQ2d 1396. "Under the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." *Id.* at 1742, 82 USPQ2d at 1397.

Further, all benefits of claimed invention need not be explicitly disclosed in reference to render claim unpatentable under 35 USC 103. See *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990). Since the claimed subject matter would have been obvious from the references, it is immaterial that the references do not state the problem or advantage ascribed by applicant. See *In re Wiseman*, 201 USPQ 658. The law does not require that references be combined for the reasons contemplated by the inventor. *In re Beattie*, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992).

Conclusion

As new grounds of rejection are presented, this Office Action is made **NON-FINAL**.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Greg Pickett/
Primary Examiner
Art Unit 3728

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below.


Mickey Yu
Supervisory Patent Examiner
Group 3700